

Remarks

Entry of the foregoing and further and favorable reconsideration of the above-identified application is respectfully requested. By the foregoing amendment, claims 1 and 16 have been amended to recite that the sodium channel blocker is selected from the group consisting of lamotrigine, crobenetine, oxcarbamazepine and phosphenytoin, and that the selective serotonin uptake inhibitor is selected from the group consisting of fluoxetine, paroxetine, duloxetine, sertraline, escitalopram and citalopram. Support for this amendment to claims 1 and 16 may be found, at the very least, on page 4, lines 6-17. Moreover, claims 2, 3, 18, 19 have been canceled, without prejudice or disclaimer to the subject matter disclosed therein. Applicants reserve the right to pursue the canceled subject matter in a continuation application. No new matter enters by way of this amendment.

Applicants hereby incorporate by reference the arguments made in the Amendment and Response Under 37 C.F.R. § 1.116, filed on February 25, 2011, with respect to the rejections of the claims under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 103.

Applicants representative would like to thank the Examiner for the courtesy provided to her during a telephone conference on March 22, 2011, regarding the above-identified application. During this telephone conference, the Examiner indicated that the claims would be allowed if amended to limit the sodium channel blocker to lamotrigine and the serotonin uptake inhibitor to sertraline, the species elected by the applicants in response to an election of species requirement made by the Examiner in an Office Action dated April 21, 2009. The Examiner further indicated that the scope of examination would not be expanded to include the non-elected claims.

Applicants respectfully point out that while the Examiner is permitted to require election of a single species for prosecution on the merits, as was done in the present application, once the elected species is found allowable over the prior art (which the Examiner has indicated is the situation here), examination of the non-elected subject matter must be extended to determine patentability of the claim(s) as a whole.

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species . . .

M.P.E.P. § 803.02 (Emphasis added). The section of the M.P.E.P. goes on to state that should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *nonelected species*, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species.

(*Id.*) (emphasis added).

In fact, in the April 21, 2009, Office Action, the Examiner stated:

Upon allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

(4/21/09 Office Action at 4) (emphasis added). The Examiner is free to choose any non-elected species for which to extend the search in order to determine patentability of the Markush-type claims. However, in these circumstances the Examiner is not permitted to require cancellation of the non-elected subject matter. The M.P.E.P. recognizes the impracticality and infeasibility of filing separate patent applications for each of the species. Therefore, the applicants respectfully request that the examination of the above-identified application be extended, as necessary, to determine the patentability of the non-

elected subject matter (*i.e.* the use of a sodium channel blocker selected from crobenetine, oxcarbamazepine and phosphentyoin (in addition to lamotrigine), and the use of a serotonin uptake inhibitor selected from (in addition to sertraline) fluoxetine, paroxetine, duloxetine, escitalopram and citalopram) in the claimed pharmaceutical compositions and methods.

Conclusion

Examination and further and favorable reconsideration of this Application is respectfully requested.

Applicants believe that the present Application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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